

ESTTA Tracking number: **ESTTA959347**

Filing date: **03/11/2019**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91231507
Party	Defendant Ole Smoky Distillery, LLC
Correspondence Address	MICHAEL E ROBINSON ROBINSON IP LAW PLLC 9724 KINGSTON PIKE STE 1403 KNOXVILLE, TN 37922-6907 UNITED STATES rrobinson@robinsoniplaw.com, docketing@robinsoniplaw.com 865-978-6480
Submission	Motion to Amend Application
Filer's Name	Michael E. Robinson
Filer's email	docketing@robinsoniplaw.com, rrobinson@robinsoniplaw.com
Signature	/michael e robinson/
Date	03/11/2019
Attachments	01183-20190311-tottab-MotToAmendApplication.pdf(134764 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

IN THE MATTER OF APPLICATION

Mark: OLE SMOKY MOUNTAIN DEW MOONSHINE
Applicant: Ole Smoky Distillery, LLC
Serial No.: 86/762,399
Filed: September 21, 2015
Published: August 2, 2016

<hr/>)	
PEPSICO, INC.,)	
)	
Opposer and Counterclaim Defendant,)	Opposition No.: 91231507
)	
v.)	
)	
OLE SMOKY DISTILLERY, LLC,)	
)	
Applicant and Counterclaim Plaintiff.)	
<hr/>)	

**APPLICANT OLE SMOKY DISTILLERY, LLC’S MOTION AND MEMORANDUM IN
SUPPORT OF ITS MOTION TO ENTER A DISCLAIMER OF THE TERM “MOUNTAIN
DEW” WITHOUT CONSENT AND TO STAY THIS PROCEEDING PENDING RESOLUTION
OF THIS MOTION**

Pursuant to 37 CFR § 2.133, Applicant Ole Smoky Distillery, LLC (“Applicant” or “Ole Smoky”) respectfully moves to disclaim the term “MOUNTAIN DEW” in application serial number 86/762,399 such that all of the phrase “MOUNTAIN DEW MOONSHINE” is disclaimed from Applicant’s OLE SMOKY MOUNTAIN DEW MOONSHINE Mark. Ole Smoky further respectfully moves that the Board suspend this proceeding until the Board has made a determination on Applicant’s motion to amend.

I. Background

After Applicant filed its application for the Mark OLE SMOKY MOUNTAIN DEW MOONSHINE on September 21, 2015, a non-final office action (the “Office Action”) was issued by the USPTO on December 9, 2015. In the Office Action, the Examining Attorney made a disclaimer requirement requiring Applicant to disclaim the phrase “MOUNTAIN DEW MOONSHINE” because “it merely describes an ingredient, quality, characteristic, function, feature, purpose, or use of [A]pplicant’s goods” [Office Action]. The Office Action went on to cite an attached dictionary definition wherein the Examining Attorney asserted that “the word MOUNTAIN DEW is another name for ‘moonshine’ which is in turn defined as an intoxicating liquor” [Office Action]. The Examining Attorney concluded that because Applicant’s goods are intoxicating liquors, the wording MOUNTAIN DEW MOONSHINE “is descriptive and must be disclaimed” [Office Action].

Although Applicant argued against and overcame the disclaimer requirement based on a declaration by John Robert McCulloch included in a response filed on June 2, 2016, Applicant nonetheless argued in the alternative in its affirmative defenses in its Answer and Counterclaims [Docket #4] that “to the extent that Ole Smoky’s or its predecessor in interest’s MOUNTAIN DEW mark has not acquired secondary meaning for distilled spirits, the phrase ‘mountain dew’ is merely descriptive of Applicant’s goods, and therefore Applicant’s mark is not likely to cause confusion with Opposer’s MOUNTAIN DEW marks” [Docket #4].

II. Argument

Under 37 CFR § 2.133, a trademark application can be amended during an Opposition proceeding upon motion granted by the Board at the Board’s discretion. Under TBMP § 514.03, such amendment can be made without the consent of the opposing party. Such motion should

“ordinarily be made prior to trial, in order to give the other party or parties notice thereof.” TBMP § 514.03. In this case, Applicant is making its motion prior to trial to provide such notice and, therefore, the motion is timely. The purpose of this motion is for Applicant to disclaim the entire phrase “MOUNTAIN DEW MOONSHINE” and thereby simplify the issues of this case prior to trial. With such a disclaimer, Applicant would not need to argue that it has acquired exclusive rights in MOUNTAIN DEW for distilled spirits. Additionally, Opposer PepsiCo, Inc. (“PepsiCo”) would not need to argue that Applicant has not acquired rights in MOUNTAIN DEW for distilled spirits because the issue would be conceded. Thus, the entry of this disclaimer will reduce the issues for trial and thereby simplify the case as a whole.

Although “[t]he Board generally will defer determination of a timely filed (i.e., pretrial) unconsented motion to amend in substance until final decision,” Applicant respectfully asserts that in this case, a determination made by the Board at this juncture in the case will allow the parties to know whether or not to even try certain issues. If the motion is granted, resources can be conserved by not having to litigate those specific issues. If the Board defers a determination on this motion until the end of the case (final decision) and grants such motion, any benefit of simplifying the issues for trial would be lost because all of the issues would have already been addressed and litigated during the trial period. Therefore, Applicant respectfully requests that a determination on this motion be made prior to the trial phase of this case.

For the reasons set forth above, Ole Smoky respectfully requests that its motion be granted and (if necessary) that trial dates be reset after a decision on this motion has been made by the Board.

Respectfully submitted this 11th day of March, 2019.

ROBINSON IP LAW, PLLC

By: Michael E. Robinson
Michael E. Robinson
Matthew M. Googe
ROBINSON IP LAW, PLLC
9724 Kingston Pike, Suite 1102
Knoxville, TN 37922
Phone: (865) 978-6480
Fax: (865) 978-6493
rrobinson@robinsoniplaw.com
mgooge@robinsoniplaw.com
ATTORNEYS FOR APPLICANT

CERTIFICATE OF SERVICE

This is to certify that a true and correct copy of the foregoing is being served on counsel of record by electronic mail addressed as follows:

Paul Reilly
Baker Botts LLP
30 Rockefeller Plaza
New York, NY 10112-4498
paul.reilly@bakerbotts.com
tyler.beas@bakerbotts.com
nytmdpt@bakerbotts.com

Date: March 11, 2019

By: Michael E. Robinson
Michael E. Robinson